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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,539	10/26/2001	Masashi Ogawa	JG-SIK-5112/500676.20006	2479

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REED SMITH, LLP
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EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 08/19/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,539

Applicant(s)

OGAWA ET AL.

Examiner

Francisco C Prats

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-13 are presented for examination.

Election/Restrictions

Applicant's election without traverse of the group I invention, claims 1-10, in Paper No. 9, filed July 16, 2003, is acknowledged. Claims 11-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. As noted, election was made **without** traverse.

Claims 1-10 are examined on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered

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therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer et al (U.S. Pat. 5,985,085).

Baer discloses the use of colored or dyed films in laser capture microdissection processes wherein the film is placed on a glass support. See, e.g., column 8, lines 43-46:

The LCM transfer film can include an absorptive substance. The absorptive substance can include an absorptive dye. This dye can be either a broad band absorptive dye or a frequency specific absorptive dye.

Baer differs from the claims in failing to disclose in a single embodiment the use of a colored film wherein the film also has a thickness of from 3 to 6 μ M, as recited in the claims. However, Baer clearly discloses that thin films are desirable in laser capture microdissection processes. See column 6, lines 32-37:

It is advantageous that the LCM transfer film 400 be thin. For example, a 50 micron thick film is preferable to a 100 micron thick film. However, the film can advantageously be fabricated in thicknesses of approximately 500, 400, 300, 200, 100, 50 microns, **or less**. (Emphasis added.)

Thus, although Baer does not explicitly disclose the claimed film thickness range, Baer clearly discloses the desirability of

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using thin films. The artisan of ordinary skill would therefore clearly have been motivated to have employed a film having the claimed thickness in the process disclosed by Baer. Lastly, the determination of a suitable polymer film, such as the aramid recited in claim 7, must be considered obvious in view of Baer's disclosure that a wide variety of polymeric films are suitable in the processes disclosed therein. See column 8, lines 33-42. A holding of obviousness over the cited claims is clearly required.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer et al (U.S. Pat. 5,985,085) in view of Schütze et al (Cellular and Molecular Biology 44(5):735-746 (1998)).

As discussed above, Baer discloses the use of colored or dyed films in laser capture microdissection processes wherein the film is placed on a glass support, and also suggests using a film of the claimed thickness. Baer differs from the cited claims in failing to disclose the use of a UV laser in the laser capture microdissection process. However, Schütze clearly discloses that UV lasers possess certain advantages over infrared lasers, such as those used in Baer, in microdissection processes. Such advantages include much smaller minimum sample

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size allowing for dissection of subcellular structures such as chromosomes, avoidance of sample heating, and a clearer separation between selected and non-selected areas. See Table 1 on page 744. Thus, the artisan of ordinary skill, recognizing from Schütze the advantages of using UV lasers to dissect small samples, clearly would have been motivated to have used the UV laser technique of Schütze to dissect biological samples, using the colored absorptive films of Baer. Moreover, Schütze's disclosure that the UV laser method may use a 1-3 μM thin polyethylene foil (see, e.g., Table 1 on page 744), provides additional motivation for using a film of 3 to 6 μM , as recited in applicant's claims. A holding of obviousness is clearly required.

No claims are allowed.

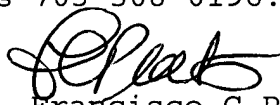
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C Prats whose telephone number is 703-308-3665. The examiner can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Wityshyn can

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- be reached on 703-308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Francisco C Prats
Primary Examiner
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FCP